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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,465	09/19/2003	Janusz A. Kuzma	05-00673-02	8344
23845	7590	05/24/2007	EXAMINER	
ADVANCED BIONICS CORPORATION			EVANISKO, GEORGE ROBERT	
25129 RYE CANYON ROAD				
VALENCIA, CA 91355				
ART UNIT		PAPER NUMBER		
3762				
MAIL DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/666,465	KUZMA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	George R. Evanisko	3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 13 November 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-6 and 8-27 is/are pending in the application.
- 4a) Of the above claim(s) 14-19 is/are withdrawn from consideration.
- 5) Claim(s) 10 and 23 is/are allowed.
- 6) Claim(s) 1-6,8,9,11-13,20,22 and 24-27 is/are rejected.
- 7) Claim(s) 21 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/27/07</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

Claims 14-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in a telephone conversation with Bryant Gold on 6/22/06.

Claim 13 contains the trademark/trade name Teflon. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe PTFE and, accordingly, the identification/description is indefinite.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6, 8, 9, 11-13, 20, 22, and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuzma (6119044).

Kuzma discloses the claimed invention having a precurved or hooked shape (e.g. col. 4, line 48, figure 16), having a stylet channel, 11, a tapered array with super-flexible/soft tip not including a stylet channel (e.g. figure 4, col. 11, lines 25-40), and wrapping around 1 turn but not more than two (e.g. figure 16). Kuzma does not disclose the zigzagged conductors, capping of the stylet channel, the use of an overmold having a cross-configured slit for the cap, a malleable ring that can be crushed to seal the slit, and the stylet channel having a Teflon tube. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the implantable catheter as taught by Kuzma, with the zigzagged conductors, capping of the stylet channel, the use of an overmold having a cross-configured slit for the cap, a malleable ring that can be crushed to seal the slit, and the stylet channel having a Teflon tube since it was known in the art that implantable catheters use: zigzagged conductors to allow the catheter to easily expand, contract and bend; capping of the stylet channel to allow or prevent the selective entry of elements into the channel; the use of an overmold having a cross-configured slit for the cap to provide a conventional, well-tested means to seal the channel but still allow a guide for entry of elements into the channel; a malleable ring that can be crushed to seal the slit to provide

an additional/redundant means to seal the overmold and provide a compressive seal, and the stylet channel having a Teflon tube to prevent the stylet from puncturing the catheter and/or allowing easily entry and removal of the stylet.

In addition, for claims 6 and 24, Kuzma's two most distal electrodes and tip 37 are considered the distal tip having a subset electrode array and super flexible tip. It is noted that the claims do not state that the super-flexible tip is the entire distal tip containing the electrodes. In the alternative, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the implantable catheter as taught by Kuzma with a super flexible tip with a subset of electrodes since it was known in the art that implantable catheters include a super-flexible tip with electrodes to provide low insertion and low bending forces required to push the array around the coil, upward spiraling geometry of the inner ear.

#### ***Allowable Subject Matter***

Claims 10 and 23 are allowed.

Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. The argument on page 10 that a proper obviousness rejection would have included another reference is not persuasive. According to MPEP 2144, sources of rationale supporting a rejection under 35 U.S.C. 103 may be in a reference or reasoned from common knowledge in the art, etc. The rationale to modify or combine the prior

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art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. Therefore, another reference is not always need to support a rejection under 35 USC 103.

The argument that Kuzma doesn't mention a zigzagged wire (super flexible tip, capping a channel, etc) is correct. Although, that is why the 103 rejection was provided to show it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the zigzagged wire, etc. In addition, the argument that Kuzma does not disclose any suggestion or motivation to use a zigzagged wire (super flexible tip, capping a channel, etc.) is also correct. Although, the suggestion or motivation can be provided by another reference, reasoned from knowledge generally available to one of ordinary skill in the art, legal precedent, etc. In all instances, the Examiner has provided the suggestion or motivation (as seen in the 103 rejection above).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mann is one example of many describing a malleable ring to compress an overmold and other capping means to seal a catheter channel. Dadd et al is another example of many describing a super soft/flexible tip and plug/capping means for a catheter channel. Berrang, Tschida, Hochmair, and Pohndorf are four examples of many showing the use of zigzagged conductors in implantable catheters and Pohndorf further describes the use of a Teflon stylet

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channel. Jolly is one example of many showing the use of a super-flexible tip with subset of electrodes and different seals/capping means.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R. Evanisko whose telephone number is 571 272 4945. The examiner can normally be reached on M-F 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571 272 4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

George R Evanisko  
Primary Examiner  
Art Unit 3762

5/19/7

GRE  
May 19, 2007